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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,629	05/17/2001	Michael Wengrovitz	41888/JEC/X2	3310

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ALCATEL INTERNETWORKING, INC.
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EXAMINER

LE, DAVID Q

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,629

Applicant(s)

WENGROVITZ, MICHAEL

Examiner

David Q Le

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all passages in the cited references as potentially teaching all or part of the claimed inventions.

Status of Claims

2. Per the Amendment filed on January 26, 2004:

Claims 1-15 are unchanged.

Claims 16-25 are added.

Claims 1-25 remain pending.

Response to Request for Reconsideration

3. In the Remarks filed with the Amendment of January 26, 2004, Applicant notes that an error was made regarding the effective date of the Rumsey reference. This is correct: the effective date of the Rumsey reference is January 9, 2001, not January 9, 1999.

4. The declaration (Appendix) filed on January 26, 2004 under 37 CFR 1.131 is insufficient to overcome the Rumsey reference:

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Rumsey reference.

Applicant's declaration under 37 CFR § 1.131 states that the invention was conceived on October 10,

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2000, and that it was submitted for preparation as a patent application and filed May 17, 2001. The May 17, 2001 date may be considered the constructive reduction to practice date for the invention, but it does not predate the effective date of the Rumsey reference, January 9, 2001.

The evidence submitted is also insufficient to establish diligence from a date prior to the date of reduction to practice of the Rumsey reference to either a constructive reduction to practice or an actual reduction to practice. There was no evidence in the declaration filed with the January 26, 2004 Amendment supporting that such diligence was exercised between the claimed date of conception of the invention, October 10, 2000, and May 17, 2001, the filing date for the instant application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rumsey, US Patent Publication No. US 2002/090072 A1, of Application No. 09/757,754, filed January 9, 2001.

As per claims 1, 8 and 12.

Rumsey discloses

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A [system/ticket collector/method] for providing call accounting services (Abstract; Summary of the Invention), the system comprising:

- a first network (Par. 8, 27-29: "a hotel/hotel chain") collecting ...call parameter information; and
- a second network (Par. 27 "a remote call accounting service/service provider") receiving ... and processing the call parameter information for generating a usage profile (Par. 23-24: "a hotel guest's phone bill");

wherein the call parameter information is transmitted from the first network to the second network over a public computer network (Par. 21: "the Internet").

Rumsey does not disclose encrypting and decrypting the transmissions between the client network and the service provider network. However he does teach that security of data is important, and that passwords may be used to protect said data (Par. 30). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to add encryption and decryption methods to those transmissions, in order to further increase the security of proprietary and sensitive financial information belonging to the client organization as well as to the individual users of the system.

As per claims 16, 21, and 24.

Rumsey discloses all the functional limitations recited in these claims (see all above citations):
a call accounting application service provider network receiving call parameter information and deriving from this information a usage profile, in the service of
an enterprise network (in Rumsey, a network of hotels) equipped with a PBX system,
over a public network such as the Internet.

Rumsey does not recite the various technical components of this system:

- an "intelligent ticket collector";
- a storage device for storing and buffering the call information;
- input and output devices;
- an encryptor for encrypting and decrypting the call information, prior to and after transmission;
- data transfer protocol stack;
- switching nodes;
- a network access server.

However, all of the above are electronic hardware, software, and firmware components well-known in the art, inherently required in the set up, operation, and maintenance of a network as

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described by Rumsey, well within the knowledge of one ordinarily skilled in the art at the time the invention was made. Therefore it would have been obvious that the system would have to possess all of these claimed devices in order to function properly. The only non-inherent feature of the claimed invention would be encrypting the data transmissions to and from the enterprise network. However, in this case, as analyzed in the previous set of independent claims, Rumsey does teach that security of data is important, and that passwords may be used to protect said data (Par. 30). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to add encryption and decryption methods to those transmissions, in order to further increase the security of proprietary and sensitive financial information belonging to the client organization as well as to the individual users of the system.

As per claim 2.

Rumsey discloses all the limitations of claim 1.

He further discloses

.. the first network is an enterprise network (a hotel chain).

As per claim 3.

Rumsey discloses all the limitations of claim 1.

He further discloses

the first network includes a private branch exchange unit for generating the call parameter information (Par. 21: "PBX");

Rumsey does not disclose

a storage device for storing the call parameter information; and

an encrypter for encrypting the call parameter information.

However storage devices and encryption methods are well known and widely used in the art, and it would have been obvious to one ordinarily skilled in the art at the time the invention was made that the system envisioned by Rumsey would inherently have storage devices to store call parameter information, should batch processing of call data be chosen as a preferred embodiment, for non time-sensitive applications. Likewise, encryption methods would have been an obvious addition to the Rumsey system, in order to further provide security for the transmissions between client organization and the remote call accounting system.

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As per claim 4.

Rumsey discloses all the limitations of claim 1.

He does not specifically disclose

...the second network is a service provider network.

However he does mention that the remote call accounting system would be provided by a service provider (Par. 27). It would have been obvious to one ordinarily skilled that a service provider in the business of providing accounting services to an enterprise such as a hotel chain in all likelihood would inherently have a network of servers and storage devices to accommodate the high volume of data that would be coming from such large clients.

As per claims 5, 9 and 13.

Rumsey discloses all the limitations of claim 1, 8 and 12.

He further discloses

... the public computer network is a public internet (Par. 21).

As per claims 6, 10, 14, 18, 23, and 25.

Rumsey discloses all the limitations of claims 1, 8, 12, 16, 21, and 24.

He does not specifically disclose using email as a method for the remote call accounting service to report back to the client organization a user profile.

However Rumsey does disclose using a public network, the Internet, for communicating between all parties to the system. Therefore it would have been obvious of ordinary skill in the art at the time of the invention that email would be one method for transmitting such user profiles back to the client organization. Such a method would obviate the need for the client organization's administrative staff to access the RCAS system to download or view the profiles generated by the RCAS system, thus making it more attractive to potential users.

... information is transmitted via electronic mail.

As per claims 7, 11 and 15.

Rumsey discloses all the limitations of claim 1, 8 and 12.

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He further discloses

... the usage profile includes call cost information (Par. 28).

As per claims 17, 19, 20, and 22.

Rumsey discloses all the limitations of claims 16 and 21.

He does not specifically describe

a network access server (claims 17 and 22)

a storage device and buffers connected to the PBX (claim 19)

switching nodes (claim 20).

However, all of the above are electronic components well known in the art, inherently required in the set up, operation, and maintenance of a network as described by Rumsey, well within the knowledge of one ordinarily skilled in the art at the time the invention was made. Therefore it would have been obvious that the system would have to possess all of these claimed devices in order to function properly.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

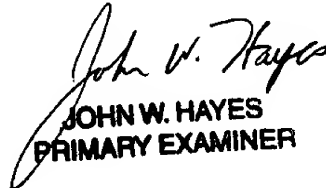
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DQL


JOHN W. HAYES
PRIMARY EXAMINER